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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,053	01/29/1999	CLEMENT W. BOWMAN	PROGRID	6857
22191	7590	03/11/2008		
GREENBERG TRAURIG, LLP				
1750 TYSONS BOULEVARD, 12TH FLOOR				
MCLEAN, VA 22102				
EXAMINER				
NAJARIAN, LENA				
ART UNIT		PAPER NUMBER		
3626				
NOTIFICATION DATE		DELIVERY MODE		
03/11/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kinneyb@gtlaw.com

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**Office Action Summary****Application No.**

09/240,053

**Applicant(s)**

BOWMAN, CLEMENT W.

**Examiner**

LENA NAJARIAN

**Art Unit**

3626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the response filed 11/5/07. Claims 1-20 remain pending.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to the claim limitation "establishing a first independent variable and a second independent variable ....," Applicant has provided various portions of the specification to comply with the enablement requirement. The Examiner respectfully submits that page 6, line 18 through page 7, line 15, and Figures 1a-1d, 4a-4b, 5, 6, 8, 10, 11, and 12 merely contain examples of independent variables. Applicant has failed to describe how to "establish a first independent variable and a second independent variable related to the value of said specific intangible asset of interest" in the specification in such a way as to

Art Unit: 3626

enable one skilled. How would one skilled in the art know which independent variables should be established? There is no description of how this is done other than by providing examples.

Furthermore, the examples of variables starting on page 6 of the specification are not well-defined. For example, on page 7 the specification identifies variables such as "teaching excellence" and "research excellence." These are not readily quantifiable values and are therefore "fuzzy" measures. The specification is silent as to how the variables are set up.

With respect to the claim limitation "establishing a series of performance criteria statements probative of the value of said first and second independent variables," Applicant has provided various portions of the specification to comply with the enablement requirement. The Examiner respectfully submits that page 7, line 10 to page 10, line 5 and Figure 2 are identified as examples of how to establish performance criteria statements. The example in Figure 2 is related to patents. Examples are not given for other intangible assets of interest, such as universities. The Examiner respectfully submits that page 8 of Applicant's specification states "The performance criteria can be defined by persons with extensive experience in the type of organization or asset being evaluated, or can be selected from a data base of previously established matrices for similar organizations." Applicant has failed to provide support to enable "establishing a series of performance criteria statements" other than to state that a human could select them or that a database could be used. But it remains unclear how a

human would know what a series of performance criteria statements probative of the value of said first and second independent variables. Applicant has provided no guidance as to how someone would do this. As such, Applicant has failed to describe the claimed limitation in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to the claim limitation "scoring each of said performance criteria statements," Applicant has provided various portions of the specification to comply with the enablement requirement. The Examiner respectfully submits that these portions of the specification do not teach "scoring each of said performance criteria statements" which Applicant describes at page 10 as being done by an evaluator. The evaluator's results are compiled and put into a form as shown in Figure 3. The issue remains as to how an evaluator scores each of said performance criteria statements other than randomly selecting the statement that he thinks best describes the organization or asset being evaluated. Applicant has failed to describe the scoring of said performance criteria statements in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(A) The basis for the rejection of claims 1-20 under 35 U.S.C. 101 in the previous Office Action was that the claims do not produce a concrete result. The issue is not whether the claimed invention will always result in physical media with two axes physically plotted thereon, but *where* the point on the chart is going to be. As was explained in the 112 rejection above, the variables used to ultimately create the point are fuzzy measures.

Applicant's claimed invention fails to provide a concrete result because it is not reproducible. Claim 1 recites "establishing a first independent variable and a second independent variable..." and "establishing a series of performance criteria statements..." Applicant provides an example of these steps based on Applicant's specification. These steps are performed by a user who establishes both the variables and the performance criteria. These steps fail to recite any objective means, steps or guidelines for how a user is to determine the independent variables and the performance criteria. Each time a user establishes the variables and performance criteria, different steps could be taken by the user. Furthermore, claim 1 recites "scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest." Applicant's specification describes this step at page 10. "An evaluator... selects (e.g., by circling) for each of the criteria the one statement which best describes

Art Unit: 3626

the organization or asset being evaluated." This step of scoring does not provide any objective means or steps to score the performance criteria statements. Each time an evaluator "scores" the performance statements different steps could be taken.

Thus, each time a chart is plotted it will be different depending on the subjective input of a user. Each time a user goes through the method, they could chose different independent variables, performance criteria, and scoring for the same intangible asset. Since the variables are fuzzy measures, there is no predictability and repeatability. Thus, the result would be different each time the method is performed. This is not a concrete result because it is not repeatable or predictable. Thus, while claim 1 produces a tangible and useful result, claim 1 fails to produce a concrete result.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a method of and system for valuing elements of a business enterprise (US 2001/0041996 A1).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

Art Unit: 3626

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571)272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. N./  
Examiner, Art Unit 3626  
In  
2-28-08

/Robert Morgan/  
Primary Examiner, Art Unit 3626